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09/955,804	09/19/2001	Thomas J. Pavela	ST9-98-107US2	1404

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Attention of Victor G. Cooper  
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EXAMINER

VO, TED T

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 12/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/955,804

Applicant(s)

PAVELA, THOMAS J.

Examiner

Ted T. Vo

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. This action is in communication to a Preliminary Amendment filed on 9/19/2001.

Claims 1-21 are canceled, and new claims 22-36 are added, and the specification is amended via the Preliminary Amendment.

Claims 22-36 are pending in the application.

#### ***Drawings***

2. The proposed drawing changes were received on 9/19/01. These drawing changes are accepted for examination purpose.

#### ***Response to Arguments***

3. Applicant's arguments in section remarks (pages 9-11) of the Preliminary Amendment with respect to claims 22-36 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 22-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being respectively unpatentable over claims 1-4, 6, 7-10, 12, 13-16, 18 of U. S. Patent No. 6,332,211. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

As per claims 22-26:

Regarding independent claim 22: Claim 22 and claim 1 in US 6,332,211 are claiming the same steps of a method for generating test code (for comparing, see US 6,332,211, column 12, claim 1, started at line 19).

Regarding claims 23-26: Claims 23-26 and claims 2-4, 6 in 6,332,211 are respectively claiming the same steps of a method for generating test code (for comparing, see US 6,332,211, column 12, claims 2-4, 6).

As per claims 27-31:

Regarding independent claim 27: Claim 27 and claim 7 in US 6,332,211 are claiming the same means of an apparatus for generating test code (for comparing, see US 6,332,211, columns 12-13, claim 7, started at line 62 of column 12).

Regarding claims 28-31: Claims 28-31 and claims 8-10, 12 in US 6,332,211 are respectively claiming the same means of an apparatus for generating test code (for comparing, see US 6,332,211, column 13, claims 8-10, 12).

As per claims 32-36:

Regarding independent claim 32: Claim 32 and claim 13 in US 6,332,211 are claiming the same steps in a program storage device (for comparing, see 6,332,211, columns 13-14, claim 13, stated at line 39 of column 13).

Regarding claims 33-36: Claims 33-36 and claims 14-16, 18 in US 6,332,211 are respectively claiming the same steps of a program storage device (for comparing, see US 6,332,211, column 14, claim 14-16, 18).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 22-24, 26-29, 31-34, 36 are rejected under 35 U.S.C. 102(a) as being anticipated by Smith (Smith Jr.) (US No. 5,754,755).

Given the broadest reasonable interpretation of followed claims in light of the specification.

As per claim 22:

Smith discloses "***defining a source file having a plurality of tags*** (see figure 1, reference numbers 112 and 114, and see column 7, lines 25-30, 'HTML template file'), ***each tag*** ('placeholder' or tags in HTML template file) ***associated with a member of a library of executable code objects defining a set of instructions for performing a portion of automatic test procedure***" (see column 5, lines 49-65, 'OBJECT1, OBJECT2, OBJECT3').

Smith discloses, "***generating a test plan in a conversational language from the source file***" (see column 7, lines 42-47, 'the generator is particularly useful in generating documents that describes a test plan').

Smith discloses, "***generating the test code*** ('test instructions') ***for the automated test procedure*** ('application-specific test script') ***from the source file*** ('test template file')" (See column 2, lines 45-58, referring to 'test instructions' line 47, 'application-specific test script' line 58, 'test template file' line 46).

As per claim 23:

Smith discloses, "***The method of claim 22, wherein the step of generating a test plan comprises the steps of: translating the tags; and generating a conversational language phrase for each translated tag***", by using a generator to convert the template included with test plan documentation into a test plan document (see Smith: column 7, lines 40-47, 'the generator is particularly useful in generating documents')(Examiner note: HTML script is translated by a Web browser into readable text).

As per claim 24:

Smith discloses, "***the method of claim 23 wherein the test plan comprises a test index identifying the system elements tested by the test code***" (As mentioned, Smith discloses test script generator that can generate a customizing file [see Smith column 3, lines 29-59]. Test plan is included in this customizing file [see Smith: column 7, lines 40-47, 'the generator is particularly useful in generating documents]. Smith provides that each indexing object, OBJECT1, OBJECT2, OBJECT3 [column 5, lines 55-65; and referring column 4, lines 7-15, 'indexed placeholder'] is identified by the generator in a script generation, then the generator searches for its value and replaces the value with instructions).

Smith discloses, "***the test index generated by performing the step of scanning the interpreted tags to identify the system elements tested by the test code***" (see Smith, column 3, lines 45-48).

As per claim 26:

Smith teaches translating Test template file and Customizing file (Fig. 1, reference no. 112, and reference no. 114) into the application-specific test script by storing the values of placeholders in the Test template file and Customizing file (See column 2, lines 45-58). These Test template file and Customizing file could be HTML template files (column 7, lines 25-30). The translation includes storing the values of objects (see column 5, lines 49-65, 'OBJECT1, OBJECT2, OBJECT3'). This covers the limitation: "***where the step generating test code for automated test procedure comprises the step translating the executable***

***code object associated with the tag the source file***" (Column 2, lines 45-58; and see column 5, lines 49-65).

As per claim 27:

Claim 27 is an apparatus claim that has the functionality corresponding to the method claim 22.

Therefore, claim 27 is rejected in the same reason set forth in connecting to the rejection of claims 22.

As per claim 28:

Claim 28 is an apparatus claim that has the functionality corresponding to the method claim 23.

Therefore, claim 28 is rejected in the same reason set forth in connecting to the rejection of claims 23.

As per claim 29:

Claim 29 is an apparatus claim that has the functionality corresponding to the method claim 24.

Therefore, claim 29 is rejected in the same reason set forth in connecting to the rejection of claims 24.

As per claim 31

Claim 31 is an apparatus claim that has the functionality corresponding to the method claim 26.

Therefore, claim 31 is rejected in the same reason set forth in connecting to the rejection of claims 26.

As per claim 32:

Claim 32 is program storage device in which its claimed steps correspond to the steps recited in the method claim 22. Therefore, claim 32 is rejected in the same reason set forth in connecting to the rejection of claims 22.

As per claim 33:

Claim 33 is program storage device in which its claimed steps correspond to the steps recited in the method claim 23. Therefore, claim 33 is rejected in the same reason set forth in connecting to the rejection of claims 23.

As per claim 34:

Claim 34 is program storage device in which its claimed steps correspond to the steps recited in the method claim 24. Therefore, claim 34 is rejected in the same reason set forth in connecting to the rejection of claims 24.

As per claim 36

Claim 36 is program storage device in which its claimed steps correspond to the steps recited in the method claim 26. Therefore, claim 36 is rejected in the same reason set forth in connecting to the rejection of claims 26.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



Claims 25, 30, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (Smith, Jr.) (US No. 5,754,755).

As per claim 25:

Smith discloses a generator that generates a test plan in form of an HTML output file. The file comprises placeholders and HTML tags.

With regards to claim limitation of claim 25: ***"The method of claim 23, wherein the step of generating a test plan further comprises the steps of: identifying an un interpretable tag in the test plan; and appending the test plan with an error message identifying the un interpretable tag",***

The claim limitation has means of syntax error checking.

Smith does not address syntax error (***identifying an un interpretable tag***) that causes a returned message (***appending the test plan with an error message***) in generating a test plan using tags and placeholders.

However, syntax checking is well known in the art. Syntax is usually identified by a computer system or syntax check support of a given computer programming language. The response of a syntax error is usually returned with an error or a warning message. This is very well known in the art. For example, a prior art of record, IBM Technical Disclosure Bulletin, "FACTOR (Fairchild Sentry VIII Tester Language) SYNTAX Checker/Analyzer", discloses displaying an error message when a syntax error is occurred. Official notice is taken that syntax check is well known in the art for providing an identification of an error. It is used commonly for providing error identification of any computer execution.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include for taking advantage of the well-known feature. The motivation is provided for conforming to an execution requirement for ensuing error free.

As per claim 30:

Claim 30 is an apparatus claim that has the functionality corresponding to the method claim 25.

Therefore, claim 30 is rejected in the same reason set forth in connecting to the rejection of claims 25.

As per claim 35:

Claim 35 is program storage device in which its claimed steps correspond to the steps recited in the method claim 25. Therefore, claim 35 is rejected in the same reason set forth in connecting to the rejection of claims 25.

**Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**IBM Technical Disclosure Bulletin**, "FACTOR (Fairchild Sentry VIII Tester Language) SYNTAX Checker/Analyzer", discloses an error message is displayed when a syntax error is occurred.

**Naiknaware**, "Analog Automatic Test Plan Generator – Intergrating with Modular Analog IC Design Environment", IEEE, discloses a test plan that can be converted into a test program.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (703) 308-9049. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM ET. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam, can be reached on (703) 305-4552.

The fax phone numbers:

(703) 872-9306 (for formal communication intended for entry);

(703) 746-5429 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

*TED T. VO*

Patent Examiner  
Art Unit: 2122  
November 24, 2003